

REMARKS/ARGUMENTS

These remarks are submitted responsive to the Office Action dated July 31, 2006 (Office Action). As this response is timely filed before the expiration of the 3-month shortened statutory period, no fee is believed due.

In the Office Action, each of the claims was rejected on the basis of new grounds of rejection. Claims 1, 2, 4, 5, 7-10, 12, 13, 15-18, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,818,920 to Rignell, *et al.* (hereinafter Rignell) in view of U.S. Patent Number 6,934,543 to Wang, *et al.* (hereinafter Wang). Claims 3, 6, 11, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rignell in view of Wang and further in view of U.S. Patent Number 6,574,486 to Labban (hereinafter Labban). Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rignell in view of Wang and further in view of U.S. Patent Number 5,818,920 to Moon, *et al.* (hereinafter Moon). Additionally, Claims 8 and 16 were rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement.

Claim 8 has been amended to address the rejection under 35 U.S.C. § 112, first paragraph, raised at page 3 of the Office Action. Applicants respectfully submit that, as amended, Claim 8 is now supported by the sections of the Specification previously indicated by the Applicants. In regard to Claim 16, Applicants wish to point out that the previous amendments to Claim 16 were fully supported in the Specification, albeit in a different portion of the Specification than as previous indicated. (See, e.g., FIG. 2 and Specification, pg. 10, ln. 12-21 and pg. 11, ln. 1-13.) Withdrawal of these rejections to Claims 8 and 16 is therefore respectfully requested.

Applicants' Invention Predates Wang

In the Office Action, it is asserted that Wang, in combination with Rignell, Labban, and Moon, teaches or suggests every feature in the claimed invention. Applicants respectfully disagree that Wang, separately or in combination with any other cited reference, teaches or suggests every feature of the claimed invention. Applicants respectfully assert, however, that the issue is moot since the claimed invention predates the May 8, 2001, effective date of Wang. Applicants conceived of their invention at least as early as December 1, 2000, and actively pursued its reduction to practice from a date prior to the effective date of Wang. In support of their assertion, Applicants submit the Declarations attached hereto. The Declarations establish conception and continuing diligence from a time prior to the effective date of Wang to the filing of the Application.

Along with the Declarations, Applicants also submit herewith a copy of Confidential Invention Disclosure No. BOC8-2000-0107, entitled *Call Recipient Location Information Delivery for Pervasive Communication Devices* (hereinafter Disclosure). The Disclosure was submitted on December 1, 2000, by Applicants to an intellectual property (IP) professional employed by the assignee of Applicants' invention, International Business Machines (IBM). The Disclosure was insubstantially modified on December 4, 2000. No modifications were subsequently made to the Disclosure. Indeed, as discussed below, internal IBM procedures governing the use of such a disclosure expressly preclude any modification to the written description of the invention after the disclosure has been submitted.

The Disclosure explicitly describes Applicants' invention. The written description provided in the Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as December 1, 2000.

The Disclosure is an IBM confidential disclosure form. It is a standardized document that, according to established IBM procedures, is used by IBM inventors to

document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional.

The written description, drawings, and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Applicants exercised due diligence from prior to the effective date of Wang to the date that the Application was filed. As expressly affirmed in the Declarations, Applicants from at least December 1, 2000, through the filing of the Application, worked diligently toward a constructive reduction to practice of the invention, first with IBM's own in-house IP professionals, and then with outside counsel retained by IBM to prepare and file the Application.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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Disclosure BOC8-2000-0107

Prepared for and/or by an IBM Attorney - IBM Confidential

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Last Modified By: Elaine Venturelli Last Modified On: 12/04/2000 09:42:34 PM

Required fields are marked with the asterisk (*) and must be filled in to complete the form .

*Title of disclosure (in English)

Call Recipient Location Information Delivery for Pervasive Communication Devices

Summary

Status	Under Evaluation
Processing Location	[REDACTED]
Functional Area	[REDACTED]
Attorney/Patent Professional	[REDACTED]
IDT Team	[REDACTED]
Submitted Date	12/01/2000 06:28:57 PM EST
Owning Division	[REDACTED]
Incentive Program	
Lab	
	[REDACTED]
	[REDACTED]

Inventors with Lotus Notes IDs

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> denotes primary contact

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IDT Selection

Select Functional Area

IDT Team:	Attorney/Patent Professional:
[REDACTED]	[REDACTED]

Response Due to IP&L : 01/04/2001

*Main Idea

1. Describe your invention, stating the problem solved (if appropriate), and indicating the advantages of using the invention.

With the proliferation of mobile phones and pervasive communication devices (PCDs for purposes of this invention) it has become expected that people are readily available via wireless technology no matter where they may be in the world. Owners of this technology typically want to be available at reasonable times, but they have no way to inform others about their current location and timezone.

2. How does the invention solve the problem or achieve an advantage,(a description of "the invention", including figures inline as appropriate)?

Provided is a method for PCD service providers to inform callers of the PCD user's current timezone. This function will allow callers to determine if it is an appropriate time to be calling at the target user's current location. Based upon the level of urgency of the call, the caller has the opportunity to determine if their call is important enough to disturb the mobile phone user prior to the phone's ring or PCD message alert.

Via existing digital technology, the current local time of the target mobile phone can be determined. A user of a mobile phone is provided with the ability to have the local time announced to caller prior to the ring. The caller can then determine the next appropriate action (e.g. complete call and ring the mobile phone user or leave a message for the mobile phone user to be listened to at a more appropriate time).

Significantly, this invention is not limited to conveying only timezone information - it contemplates service providers' transmitting other useful data to the caller/initiator such as day-of-week (which may of course be different from the initiator's day-of-week), local holiday information, etc.

Example Situation

Mobile phone user wants to be available to receive urgent calls, but is traveling on business trip halfway around the world. Without this invention, the mobile phone user can turn the phone off while asleep in the evening or leave it on. If the phone were to be left on, the mobile phone user risks receiving calls all evening and getting no sleep. Using this invention, the mobile phone service provider informs the caller of the mobile phone user's local time so that the caller can determine if the call is important enough to wake the mobile phone user.

Scenario #1 - Example caller wishing to talk with mobile phone owner but could wait:

Caller wants to talk with mobile phone user.

Caller dials the mobile phone number.

Caller receives a brief message indicating the mobile phone user's current time based upon the tower services the mobile phone.

Caller is presented with the option of completing call by ringing the mobile phone user (press "1") or going directly to voicemail (press "2").

Caller decides to leave a voicemail by pressing "2" since the call was not important enough to probably wake the mobile phone user at 2AM.

Caller leaves a voicemail.

Caller hangs up and awaits a return call later in the day.

Scenario #2 - Example caller wishing to talk with mobile phone owner with important information:

Caller wants to talk with mobile phone user.

Caller dials the mobile phone number.

Caller receives a brief message indicating the mobile phone user's current time based upon the tower services the mobile phone.

Caller is presented with the option of completing call by ringing the mobile phone user (press "1") or going directly to voicemail (press "2").

Caller decides that the information is important enough to wake up the mobile phone user by pressing "1".

Mobile phone rings.

Mobile phone user decides whether to answer mobile phone.

Mobile phone user answers the call.

Caller and mobile phone user has conversation.

Call is completed.

Mobile phone user tries to go back to sleep after taking the appropriate action based upon the call (e.g. sell XYZ stock back home)

3. If the same advantage or problem has been identified by others (including IBM), how have those others solved it and does your solution differ and why in what way?

In a society where many people travel for business and pleasure, this invention will allow mobile phone users to be available for calls more often since the importance of a call can now be weighed by the caller prior to disturbing the mobile phone user based upon the local time, day-of-week or holiday status of the mobile phone user. Prior to this invention, mobile phone users would be disturbed by all calls or would only receive messages for all calls. There was no option allowing callers to determine the level of importance of the call, based on information provided purely by virtue of the recipient's location.

4. If the invention is a product or process, include technical details, purpose, disclosure to others and the date of that implementation.

N/A

***Critical Questions (Questions 1-8 must be answered)**

***Question 1**

[Redacted]

***Question 2**

[Redacted]

[Redacted]

[Redacted]

[Redacted]

[Redacted]

[Redacted]

***Question 3**

[Redacted]

[Redacted]

[Redacted]

[Redacted]

[Redacted]

***Question 4**

1. Name of the person who called the recipient	[REDACTED]
2. Name of the person who answered the call	[REDACTED]

*Question 5	[REDACTED]
[REDACTED]	

*Question 6	[REDACTED]
[REDACTED]	

*Question 7	[REDACTED]
[REDACTED]	
[REDACTED]	
[REDACTED]	
[REDACTED]	

*Question 8	[REDACTED]
[REDACTED]	

Question 9	[REDACTED]
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(Form Revised 12/17/97)